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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

NGUYEN, LE V

| ART UNIT | PAPER NUMBER |
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2174

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/761,977

Applicant(s)

BARILE, JOHN

Examiner

Le Nguyen

Art Unit

2174

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7, 10-21, 24-36 and 39-46.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 1/2/04 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Continuation of 2. NOTE: The new issues being a comparator compares said received audio signals from said remote participants to determine the strongest received audio signal, and wherein said comparator selects as said active participant said remote participant from which the strongest audio signal is received based on said comparing.

Applicant argued the following:

- (a) Because this amendment is supported by the specification, it is impossible for the amendment to raise a new issue or require a new search.
- (b) Kohda's workstation is not a communication terminal.
- (c) There is no indication anywhere in Kohda that any comparison between incoming signals is made.
- (d) Palmer does not teach freezing all but one of the video image of one remote participant based on the comparison of the received audio signals from the remote participants by the comparator and "highlighting by sizing" as well as by displaying alphanumeric identification.
- (e) Nothing in the modified Kohda suggests any change in orientation of images even though the word "orientation" does not appear in the claim.
- (f) Applicant notes that the arguments presented with respect to claim 1 apply with arguably even greater force to claim 15, particularly a mobile terminal that comprises "a wireless receiver...; a comparator...; a display; and a controller...". Moreover, combining Ludwig and Kohda would defeat a critical feature of Kohda.

The examiner disagrees for the following reasons:

Per (a), applicant is again reminded that:

although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is noted that the features upon which applicant relies (i.e., "[a communication terminal] wherein the comparator compares the received audio signals from the remote participants to determine the strongest received audio signal...based on the comparing") are not recited in the rejected claim(s) at the time of examination and, therefore, the amendment does raise new issue(s) and would require a new search. Applicant proceeds to express his feelings that the examiner "rather strangely asserts that this limitation is not present in claim 3" since the expressed text recently added in the current amendment was "in the original filed claim 3". The examiner is uncertain as to which "original filed claim 3" applicant is alluding to in making such conclusions. Applicant's prosecution history has been reviewed, including the first action on the merit corresponding to original claim 3 filed on 4/23/01 and the subsequent final office action corresponding to claim 3 filed on 1/2/04, and the examiner has not been able to find the alleged claim language. If by "original filed claim" applicant is referring to his own draft copy or the claims submitted as of 1/17/01, applicant's argument is moot since it is the practice of the Office to examine the claims that applicant indicates to be examined. Moreover, the examiner cannot examine unveiled draft copies or second-guess applicant's intended claims to be examined.

Per (b), since by definition a workstation is a terminal or a microcomputer connected to a network, Kohda's workstations with video conferencing capabilities (figs. 4-5; col. 6, lines 44-46; col. 7, lines 3-38; and, col. 11, lines 9-31; video conferencing inherently has a controller to display a video image in order for there to be video output), wherein video conferencing uses compressed digital images transmitted over WAN or the Internet (network), is consistent with the claim language usage of a communication terminal.

Per (c), Kohda teaches selecting an active participant by comparing or examining resemblances/differences of audio signals (figs. 4-5; col. 6, lines 44-46; col. 7, lines 3-38; and, col. 11, lines 9-31). Specifically, Kohda's selection is based on an examination between no audio signal and the presence of audio signal(s). If by selection based on a comparison of audio signals applicant meant automatically selecting based on a comparison of audio signals without user intervention, applicant is invited to do so.

Per (d), Palmer teaches a system wherein a recipient compares/examines received audio signals from remote participants and selectively mutes audio or freezes video of certain participants (col. 9, lines 19-20) and satisfies a comparator's function, which is to "[compare] received audio signals from the remote participants". Furthermore, to highlight is to alter the appearance of image(s) as a means of calling attention to them and Palmer's sizing feature highlights by altering the appearance of an image wherein such a change in size is perceptible to a viewer of the altered image. In regards to the alphanumeric identification of Tang's, the teaching extracted from Tang is to include an alternate form of highlighting already taught by Palmer, the alternate form being that of an alphanumeric identification (figs. 1B, 3, 5 and 8; col. 9, lines 29-33).

Per (e), it is suggested to applicant that if applicant wishes for the examiner to consider the word "orientation" that applicant should incorporate such language in the claims in order for it to be considered. Otherwise, arguing the modified Kohda's lack of teaching "orientation" is strictly hypothetical and unconstructive.

Per (f), applicant ascertains that the arguments presented with respect to claim 1 apply to claim 15; however, the examiner notes that the claim language "a mobile terminal that comprises "a wireless receiver..." is not incorporated in claim 1 and is, instead, inclusive to claim 15 only, which Ludwig teaches (col. 18, lines 17-20; for a comparator and display, see rebuttal (d) explaining the VIDEO conferencing system of Palmer's; and, for a controller see comment section of rebuttal (b)). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Ludwig's mobile terminal for video conferencing to Kohda's communication terminal for video conferencing is to provide a portable system with greater accessibility to users.

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